

Amendments to the Drawings

Fig. 7 is amended to move reference numbers **740, 750** up by 1 row, thereby aligning the figure with the text in paragraph **[0062]**, which is discussing “negative correlator number[s]”. As can be seen by inspection, the negative numbers in this portion of **Fig. 7** are found in the first 2 of the final 3 rows, and not in the last 2 of these final rows as originally presented.

Thus, it can be seen that no new matter is introduced with this correction.

REMARKS

The Specification and Drawings have been amended. Claims 18 - 19, 28, 33, 35 - 36, and 38 have been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 32, 34, and 37 have been cancelled from the application without prejudice (and Claims 1 - 17, 22 - 27, and 29 - 31 were previously cancelled from the application without prejudice). Claims 18 - 21, 28, 33, 35 - 36, and 38 are now in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, and claim amendments and cancellations made in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Amendment to the Specification

Paragraph [0077]¹ is amended to correct an error in the Specification as originally filed. Paragraph [0077], lines 3 - 6 incorrectly stated that the “opportunity gap numbers” shown in **Fig. 10C** were computed by “subtracting each geography profile value from the corresponding

¹ References herein to particular paragraph numbers of Applicants’ application refer to the application as published in US 2005/0222883 A1.

product profile value for each criteria that pertains to the marketplace”. As can be seen by reference to **Fig. 10C**, as well as by the text in para. [0078] as originally filed, the operands of the subtraction were inadvertently switched in paragraph [0077] as originally filed.

See, for example, row **1101** of **Fig. 10C**, having values 2 and 1. As discussed in para. [0078], the value of 2 in row **1101** is computed by a subtraction operation of (5 - 3), where 5 is the geography profile value for the “Market Opportunity” criteria of the “Geography Profile A” (i.e., the first candidate location) **900** from row **902** of **Fig. 9**, and 3 is the corresponding product profile value from row **604** of **Fig. 6** (i.e., the “WW [world-wide] Market Opportunity” within “Overall Marketplace” **420**). Similarly, as also discussed in para. [0078], the value of 1 in row **1111** is computed by a subtraction operation of (4 - 3), where 4 is the geography profile value for the “Market CGR” criteria of the “Geography Profile B” (i.e., the second candidate location) **910** from an unnumbered row following row **902** of **Fig. 9**, and 3 is the corresponding product profile value from an unnumbered row (i.e., the “WW CGR” row) following row **604** of **Fig. 6**.

Thus, it can be seen that no new matter is introduced by this correction to the Specification.

II. Proposed Replacement Drawing

A proposed replacement drawing is provided herewith for **Fig. 7**, as discussed above in “Amendments to the Drawings”. No new matter has been introduced with this proposed

replacement drawing.

III. Rejection under 35 U. S. C. §112, first paragraph

Paragraph 8 of the Office Action dated January 7, 2010 (hereinafter, “the Office Action”) states that Claims 32 - 35 and 37 - 38 are rejected under 35 U. S. C. §112, first paragraph, as failing to comply with the written description requirement. In particular, claim elements referring to “gap value” are discussed. Claims 32, 34, and 37 have been cancelled from the application without prejudice, and the claim language from these claims has been adapted (with some changes) into independent Claims 18, 28, and 36 from which they depended. This rejection is therefore respectfully traversed with respect to the claim language as currently presented in Claims 18, 28, and 36, as will now be discussed.

Applicants’ claim language is to be interpreted in light of Applicants’ disclosure. See *North American Vaccine, Inc. v. American Cyanamid Co.*, 28 USPQ 2d 1333, 1339 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1645 (1994), which held

The law is clear that “[i]f the claims, read in the light of the specification[s], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.” (emphasis added)

The disclosure includes the specification as well as the drawings. See *In re Miskinyar*, 28 USPQ 2d 1789, 1790 (Fed. Cir. 1993) (unpublished), which held

[T]he drawings may be used like the written specification to provide evidence relevant to claim interpretation. See *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) (“[I]n

those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.” (Citations omitted)). Thus, in a proceeding in the PTO the claims must be given their broadest reasonable interpretation consistent with the drawings as well as the specification.

Accordingly, the claim language is to be interpreted in light of the specification as well as the drawings.

The term “business objectives” is introduced on line 2 of Claim 18, stating “determining a set of business objectives for assessing each of a plurality of candidate locations ...” (emphasis added). Sample business objectives are illustrated in **Fig. 4**, where the business objectives are referred to in the corresponding text using the term “assessment criteria”. See para. [0025] of Applicants’ application as published, which describes **Fig. 4** as “depict[ing] sample assessment criteria for a hypothetical product for which a resource placement decision is to be made” (emphasis added). Paragraph [0040] of Applicants’ application refers to “The particular objectives to be used in an assessment [of candidate locations] ...” (emphasis added). Accordingly, it can be seen that the assessment criteria illustrated in **Fig. 4** are representative of the “set of business objectives” as recited in Claim 18. Notably, the sample assessment criteria shown in **Fig. 4** include skills **410**,² economic data **420**,³ criteria **430** pertaining to the

² See para. [0051] of Applicants’ application.

³ See para. [0053] of Applicants’ application.

candidate locations,⁴ environmental information **440** pertaining to the candidate locations,⁵ criteria **450** for product sales and delivery,⁶ and criteria **460** that pertain to products that compete with the product for which a resource placement decision is to be made.⁷

Referring now to the “determining an importance value for a first plurality of the business objectives” claim element as currently recited on line 13 of Claim 18, see at least **Figs. 4 and 6** and corresponding text in para. **[0060]**. As discussed in para. **[0060]**, a sample “product profile” is created with regard to the sample assessment criteria from **Fig. 4**, where this product profile indicates importance values for assessment criteria (which may also be referred to as “business objectives”). Notably, the sample product profile **600** shown in **Fig. 6** includes importance values for a plurality of the business objectives set out in **Fig. 4**.⁸ In this example, sample importance values are provided for assessment criteria **410**, **420**, **450**, and **460**. For example, the value of “5” assigned to skills **601** and English language fluency **602** indicates that these assessment criteria “are considered to be extremely important to this hypothetical product” for which the sample data of **Fig. 6** is presented, whereas Chinese and

⁴ See para. **[0053]** of Applicants’ application.

⁵ See para. **[0054]** of Applicants’ application.

⁶ See para. **[0055]** of Applicants’ application.

⁷ See para. **[0055]** of Applicants’ application.

⁸ Because product profile (i.e, importance) values are not necessarily appropriate for all of the business objectives, as stated in the second sentence of para. **[0060]** with regard to sample criteria **430** and **440**, the claim element on line 13 of Claim 18 refers to a “first plurality” of the business objectives.

Japanese language fluency **601** “is considered unimportant to this [hypothetical] product” as indicated by a value of “1” as shown at **603**. Thus, it can be seen that this “determining an importance value ...” claim element from Claim 18, line 13 is supported in the application as originally filed.

For the “determining, for a second plurality of the business objectives, a location-specific score for each of the candidate locations that reflects how well the candidate location meets the second plurality of business objectives” claim element as currently recited on lines 14 - 16 of Claim 18, see at least **Fig. 9** and corresponding text in para. **[0066]**. As discussed in para. **[0066]**, the values in columns **900** and **910** are geography profiles for 2 hypothetical candidate locations, with values that relate to the assessment criteria in **Fig. 4**. See also para. **[0064]**, explaining that values for each candidate location are assigned to the assessment criteria – except, in this example, for criteria that pertain to a product on a world-wide basis⁹ – to form location-specific geography profiles (referred to in Claim 18 as “location-specific score”). Thus, it can be seen that this “determining ...” claim element from Claim 18, lines 14 - 16 is supported in the application as originally filed.

For the “using the location-specific scores and corresponding ones of the importance values to compute a plurality of gap values for each of the candidate locations” claim element as currently recited on lines 17 - 18 of Claim 18, see at least **Figs. 10A** and **10C**, as well as

⁹ Because location-specific scores are not necessarily appropriate for all of the business objectives, as noted in para. **[0064]**, the claim element on lines 14 - 16 of Claim 18 refers to a “second plurality” of the business objectives.

corresponding text in paras. [0068] and [0077] - [0078]. Pertinent portions of these figures and paragraphs will now be discussed.

Referring first to para. [0068], this paragraph states “a set of skill gap numbers is computed by subtracting each geography profile value [referred to as a “location-specific score” in Claim 18] from the corresponding product profile value [referred to as an “importance value” in Claim 18] for each criteria that pertains to local skills ...”. In the example, the “criteria that pertain to local skills” are the 13 items denoted by reference number **410** in **Fig. 4**, and the 13 entries in column **1000** of **Fig. 10A** are computed using the 13 skills-related location-specific scores from column **900** of **Fig. 9** and the corresponding importance values from **Fig. 6**; similarly, the 13 entries in column **1010** of **Fig. 10A** are computed using the 13 skills-related location-specific scores from column **910** of **Fig. 9** and the corresponding importance values from **Fig. 6**.

Referring next to paras. [0077] (as amended herein) and [0078], para. [0077] states that “a set of opportunity gap numbers is computed by subtracting a product profile value [referred to as an “importance value” in Claim 18] from the corresponding geography profile value [referred to as a “location-specific score” in Claim 18] for each criteria that pertains to the marketplace ...”. In the example, the “criteria that pertains to the marketplace” are the items denoted by reference numbers **420** and **430** in **Fig. 4**. However, the geography profiles do not contain location-specific scores for the items at **420** because, as noted in para. [0064], some of the criteria pertain to a product on a world-wide basis. Accordingly, **Fig. 10C**

contains 3 gap values for each of the candidate locations, each corresponding to one of the 3 items denoted by reference number **430** in **Fig. 4**. Paragraph **[0078]** explains that the 3 entries in column **1100** of **Fig. 10C** are computed using the 3 marketplace-related location-specific scores from column **900** of **Fig. 9** and the corresponding worldwide opportunity (i.e., importance) values which are depicted at **604** in **Fig. 6**; similarly, the 3 entries in column **1110** of **Fig. 10C** are computed using the 3 marketplace-related location-specific scores from column **910** of **Fig. 9** and the corresponding worldwide opportunity (i.e., importance) values which are depicted at **604** in **Fig. 6**.

In view of the above, it can be seen that the “using the ... scores and corresponding ... values to compute a plurality of gap values ...” claim element from Claim 18, lines 17 - 18 is supported in the application as originally filed.

For the “for each of the candidate locations, using the computed gap values and the developed cost factors to yield the value for placing the resources in the candidate location” claim element as currently recited on lines 19 - 20 of Claim 18, see at least the resource placement scores¹⁰ in **Fig. 10E** and corresponding text in para. **[0069]**, referring to the “skills gap scores” in row **1240**, which represent a sum of the entries in the columns of **Fig. 10A**, and para. **[0079]**, referring to the “opportunity gap scores” in row **1230**, which represent a sum of the entries in the columns of **Fig. 10C**. Cost factors are discussed in at least paras. **[0080]** -

¹⁰ See the first sentence of para. **[0083]**, stating “The location-specific scores shown in **FIG. 10E** (which may be generally referred to as ‘resource placement scores’ ...)”.

[0083], and are illustrated by sample values in rows **1210** and **1220** of **Fig. 10E**. Thus, it can be seen that this “... using the computed gap values and the developed cost factors to yield the value ...” claim element from lines 19 - 20 of Claim 18 is supported in the application as originally filed.

In view of the above, it can be seen that the claim language from now-cancelled dependent Claim 32, which is now adapted for inclusion in independent Claim 18, is supported in the application as originally filed, and Applicants respectfully submit that Claim 18 complies with the written description requirement as currently presented. Analogous claim language is presented in independent Claims 28 and 36, and Applicants also respectfully submit that Claims 28 and 36 comply with the written description requirement. Dependent Claims 33, 35, and 38 were rejected in the Office Action because of their dependency on now-cancelled Claims 32, 34, and 37. Accordingly, it can be seen that these dependent Claims 33, 35, and 38 also comply with the written description requirement as currently presented. The Examiner is therefore respectfully requested to withdraw the §112, first paragraph rejection of all remaining claims as currently presented.

IV. Rejection under 35 U. S. C. §112, second paragraph

Paragraph 10 of the Office Action states that Claims 18 and 28 are rejected under 35 U. S. C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the term “suitable for assessing” is discussed. Claims 18 and 28 (as well as Claim 36) have been

amended to strike the word “suitable”. The Examiner is therefore respectfully requested to withdraw the §112, second paragraph rejection.

V. Rejection under 35 U. S. C. §102

Paragraph 12 of the Office Action states that Claims 18, 20 - 21, and 36 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,895,382 to Srinivasan et al. (hereinafter, “Srinivasan”). This rejection is respectfully traversed with regard to the claims as currently presented.

Applicants respectfully note that the initial burden of making out a *prima facie* case of anticipation is on the Patent Office.¹¹ When the Patent Office has made out a *prima facie* case of anticipation, the burden then shifts to the Applicants to rebut it.¹²

Applicants respectfully submit that this burden has not been met, as the Examiner has failed to cite elements in the allegedly anticipating reference that can be equated to claim elements of Applicants’ claimed invention as currently presented. The burden of rebuttal has therefore not passed to Applicants.

In particular, referring first to independent Claim 18, claim elements from now-cancelled dependent Claim 32 have been adapted for inclusion in Claim 18, as discussed above.

¹¹ *In re Bass*, 177 USPQ 178, 186 (C.C.P.A. 1973).

¹² *Id.*

Applicants note that the Office Action rejected Claim 32 only under 35 U. S. C. §112, first paragraph. Because this 35 U. S. C. §112, first paragraph rejection has been overcome, as discussed above with reference to the claim elements of amended Claim 18, Applicants respectfully submit that a *prima facie* case of anticipation has not been made out with regard to independent Claim 18, which is therefore deemed patentable over Srinivasan as currently presented. Dependent Claims 20 - 21 are deemed patentable at least by virtue of the patentability of independent Claim 18 from which they depend.

Similarly, claim elements from now-cancelled dependent Claim 37 have been adapted for inclusion in independent Claim 36, and because Claim 37 was rejected only under 35 U. S. C. §112, first paragraph and this rejection has been overcome (as discussed above), Applicants respectfully submit that independent Claim 36 is patentable over Srinivasan as currently presented.

In view of the above, the Examiner is respectfully requested to withdraw the §102 rejections of all claims as currently presented.

VI. Rejections under 35 U. S. C. §103(a)

Paragraph 14 of the Office Action states that Claim 19 is rejected under 35 U. S. C. §103(a) as being unpatentable over Srinivasan in view of Baker et al., “Project Management” (hereinafter, “Baker”). Paragraph 15 of the Office Action states that Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Publication 2005/0065831

A1 to Keay et al. (hereinafter, “Keay”) in view of Srinivasan. These rejections are respectfully traversed.

Referring first to dependent Claim 19, Applicants have demonstrated above that independent Claim 18 is patentable over Srinivasan. Dependent Claim 19 is therefore deemed patentable at least by virtue of the patentability of Claim 18 from which it depends.

Referring next to independent Claim 28, claim elements from now-cancelled dependent Claim 34 have been adapted for inclusion in Claim 28. Applicants note that the Office Action rejected Claim 34 only under 35 U. S. C. §112, first paragraph. Because this 35 U. S. C. §112, first paragraph rejection has been overcome, as discussed above, Applicants respectfully submit that independent Claim 28 is patentable over Keay and/or Srinivasan as currently presented.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejections of all claims as currently presented.

VII. Claims 33, 35, and 38

Dependent Claims 33, 35, and 38 were rejected only under 35 U. S. C. §112, first paragraph. Because this rejection has been overcome (as discussed above), Applicants respectfully submit that these dependent claims are patentable as currently presented.

VIII. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all currently-presented claims at an early date.

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